IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

	ATTY. DOCKET NO.:	**RPS920030112US2**
IN RE APPLICATION OF:	§	
	§	
SIMON CHU, ET AL.	§	**EXAMINER: NEWAY, SAMUEL G.**
	§	
SERIAL NO.: 10/674,841	§	**CONFIRMATION NO.: 4457**
	§	
FILED: 30 SEPTEMBER 2003	§	**ART UNIT: 2626**
	§	
FOR: LOCATION SENSITIVE SOFTWARE DOWNLOAD	§	
	§	

APPEAL BRIEF UNDER 37 C.F.R. 41.37

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Appeal of the Examiner's final rejection on August 3, 2007 of Claims 1-4, 6-8, 10-17 and 19 in the above-identified application. A Notice of Appeal was electronically filed in this case on October 4, 2007, and was received in the United States Patent and Trademark Office on October 4, 2007.

Appellants request a TWO MONTH EXTENSION OF TIME for the filing of the present appeal brief. Please charge the requisite fee for a TWO MONTH Extension of Time to the **DILLON & YUDELL, LLP DEPOSIT ACCOUNT No. 50-3083**. If any additional extension of time is required, that additional extension is hereby requested, and authorization is given to charge **DILLON & YUDELL, LLP DEPOSIT ACCOUNT No. 50-3083** for requisite fees attendant with said request.

The present application was originally appealed on March 2, 2007. An original Appeal Brief was filed on April 25, 2007. The August 3, 2007 final Office Action re-opens prosecution.

Thus, no additional fee, beyond that associated with an Extension of Time, for the present Appeal Brief is believed to be necessary. However, in the event that such fees are due, please charge such fees, as well as any other required fees necessary for the appeal and prosecution of the present application, to **IBM CORPORATION DEPOSIT ACCOUNT No. 50-0563**.

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 014302, frame 0940.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-4, 6-8, 10-17 and 19 stand finally rejected by the Examiner as noted in the Final Office Action dated August 3, 2007. The rejections of Claims 1-4, 6-7 and 15-17 under 35 U.S.C. § 112, first paragraph, and Claims 8, 10-14 and 19 under 35 U.S.C. § 103(a) are appealed.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the August 3, 2007 Final Office Action from which this Appeal is filed.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As recited by Appellants' exemplary independent **Claims 1 and 15** Appellants' invention provides a method for regulating a download of a software according to a physical location of a computer on which the software is to be downloaded (as supported in the originally filed specification on page 3, lines 1-3). The method comprises the steps of storing a first list of authorized location ranges where a client computer is authorized to receive a download of a first

software from a server (supported in the originally filed specification on page 7, line 2-4), determining a physical location of the client computer (supported on page 7, lines 1-2), comparing the physical location of the client computer with the first list of authorized location ranges (supported on page 7, lines 3-5), downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges (supported on page 7, lines 5-7), and downloading the first software only if the client computer does not receive information derived from a GPS signal (supported on page 9, lines 17-19). The computer program product is supported in the original specification on page 9, line 22 to page 10, line 3.

As described in exemplary **Claim 8**, the invention includes a system for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded (supported in the originally filed specification on page 3, lines 1-3). The system comprises means (supported on page 5, line 1 to page 6, line 17) for storing a first list of authorized location ranges where a client computer is authorized to receive a download of a first software from a server (supported on page 7, line 2-4), means for determining a physical location of the client computer (supported on page 7, lines 1-2), means for comparing the physical location of the client computer with the first list of authorized location ranges (supported on page 7, lines 3-5), means for downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges (supported on page 7, lines 5-7), means for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges (supported on page 8, lines 9-21), means for comparing the physical location of the client computer with the second list of authorized location ranges (supported on page 8, lines 9-21), and means for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges (supported on page 8, lines 9-21).

As recited by Appellants' exemplary dependent **Claim 14**, the present invention further provides that a physical location of a computer is determined by a "local enterprise generated signal", which may be "confined to a single room," as supported on page 8, lines 22-29.

As described in **Claim 19**, the system may further comprise means for, in response to determining that the second software is not authorized to be downloaded to the client computer at a current physical location for the client computer, evaluating subsequent alternate programs until an authorized program is located on the server, and downloading the authorized program from the server to the client computer (as supported on page 8, lines 9-21 of the present specification).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. The Examiner's rejection under 35 U.S.C. § 112, first paragraph of Claims 1-4, 6-7, and 15-17 is to be reviewed on Appeal.

B. The Examiner's rejection under 35 U.S.C. § 103(a) of Claims 8 and 10-12 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*"), and Claim 13 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*") and *Baese et al.* (USPGPub 2002/0082025 – *"Baese*") is to be reviewed on Appeal.

C. The Examiner's rejection under 35 U.S.C. § 103(a) of Claim 19 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*") is to be reviewed on Appeal.

D. The Examiner's rejection under 35 U.S.C. § 103(a) of Claim 14 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub

2002/0017977 – "*Wall*") and *Baese et al.* (USPGPub 2002/0082025 – "*Baese*") is to be reviewed on Appeal.

ARGUMENTS

A. The Examiner's rejection under 35 U.S.C. § 112, first paragraph of Claims 1-4, 6-7, and 15-17 is to be reviewed on Appeal.

The Examiner's rejection of Claims 1-4, 6-7, and 15-17 is improper since the originally filed specification fully supports the claimed features.

With regards to exemplary **Claim 1**, the Examiner states that the original specification fails to provide a written description of all claimed features, including "downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges," (see page 8, line 22 to page 9, line 13 for support), and "downloading the first software only if the client computer does not receive information derived from a GPS signal," as supported in the present specification as originally filed at page 9, lines 17-19.

In the present office action, the Examiner concedes that the specification discloses these two features. However, the Examiner then states that there is no suggestion that both conditions could occur together. Appellants respectfully dispute the Examiner's position.

The present disclosure presents several embodiments of the invention, including prohibiting the downloading of software unless a local signal (e.g., within a single room) confirms that a computer is within an authorized area (see page 8, line 22 to page 9, line 13); prohibiting the downloading of software unless no GPS signal is detected by the computer (see page 9, lines 15-21); prohibiting the downloading of software only if a GPS signal is detected (see page 9, lines 15-21). While combining the last two scenarios is an obvious self-contradiction, there is nothing contradictory or prohibited about combining the first two scenarios, as claimed in exemplary **Claim 1**. That is, these two scenarios ("authorized location" and no "GPS signal") are not mutually exclusive, as suggested by the Examiner.

The Examiner also is troubled by the limitations of "only if" found in the cited two limitations in **Claim 1**. Appellants believe that a clear reading of all of the paragraphs [0026] to [0027] provide clear support for the limitation that downloading occurs "only if" the stated pre-conditions ("client computer is within...authorized location range" and "client computer does not receive information derived from a GPS signal") exist. That is, the cited passages state that the download is predicated on the computer either being in a known authorized location, or being "deaf" to GPS information. This predicate is the same as "only if," and thus the Examiner's position is unfounded.

As the specification fully supports and enables the elements of the cited claims, this rejection is not well founded and should be reversed.

B. The Examiner's rejection under 35 U.S.C. § 103(a) of Claims 8 and 10-12 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*"), and Claims 13-14 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*") and *Baese et al.* (USPGPub 2002/0082025 – "*Baese*") is to be reviewed on Appeal.

The Examiner's rejection of Claims 8 and 10-14 is improper since the cited prior art does not teach or suggest all of the limitations of the claims.

With regards to exemplary **Claim 8**, a combination of the cited art does not teach or suggest "upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges," as supported on page 8, lines 9-21 of the present specification.

The Examiner cites *Wall* for teaching this feature at paragraph [0103]. The cited passage from *Wall* states:

> [0103] It is then determined, at step s515, whether the ("current") access/usage parameters match the ("pre-stored") permission parameters. If the parameters match ("Y"), process 500 allows normal access/usage of the controlled system/commodity, as shown by step s520. If the parameters do not match ("N"), process 500 may prohibit or limit the access/usage, as shown by step s525.

That is, *Wall* teaches that if the first program is unauthorized, then access or usage to that program is prohibited or limited. There is no teaching or suggestion of a second software, particularly one that is found on "a second list of authorized ranges" as claimed.

The Examiner also cites paragraph [0118] in *Wall*, which states:

> [0118] Still another embodiment of the invention may be designed to protect information downloaded from the web or sold on CD and DVD or other storage device as digital information. In this instance, a noise like signal may be encoded using the position (or location) data (for example summed using modified modulo arithmetic with a pseudorandom sequence). On the web, the signal, which may be unique for each location requesting a copy (thus forming permission parameters for using the information), is inserted at the time of purchase. Dealer insertion on distributed hard copy is also a possibility at time of purchase. A GPS receiver (say, receiver 101 of FIG. 1) produces a validated position (or location) (access/usage parameters), which is then used at the target site to decode and restore the signal to its original quality (step s515 of process 500). It is possible using this technique to degrade the signal only slightly, for example to analog quality, reducing its quality away from the designated site but still leaving it usable for demonstration purposes (i.e., step s525 limited usage of process 500). The degree and method chosen is flexible and depends on marketing considerations.

In this passage, *Wall* teaches that a "dirty" version of the content may be downloaded. The Examiner states that this "degraded software reads on Applicant's second download." Appellants respectfully traverse the Examiner's position. First, *Wall's* "dirty" download is obviously unusable. The present invention clearly contemplates that the second download is usable, since it is on a second list of authorized location ranges. It is axiomatic that claimed features cannot be read out of the context of the entire claim, which is what the Examiner is attempting. Thus, Appellants' second download is not equivalent to *Wall's* dirty version of a same download.

For the reasons so stated, and as the cited art does not teach or suggest all of the limitations of the presently claimed invention, this rejection is not well founded and should be reversed.

C. The Examiner's rejection under 35 U.S.C. § 103(a) of Claim 19 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*") is to be reviewed on Appeal.

The Examiner's rejection of Claim 19 is improper since the cited prior art does not teach or suggest all of the limitations of the claim.

The Examiner cites *Wall* for teaching the feature of "in response to determining that the second software is not authorized to be downloaded by the computer at a current physical location of the computer, evaluating subsequent alternate programs until an authorized program is located on the computer, and downloading the authorized program on the computer," as supported in the original specification on page 13, lines 23-26. A combination of the cited prior art, including *Wall*, and specifically the cited passage of *Wall* at paragraph [0029], makes no mention or suggestion of the feature of evaluating alternate programs in an iterative manner (as supported in Figure 3, elements 314 and 316) until an authorized program is located.

As the cited art does not teach or suggest all of the limitations of the presently claimed invention, this rejection is not well founded and should be reversed.

D. The Examiner's rejection under 35 U.S.C. § 103(a) of Claim 14 as being unpatentable over *Kyotoku* (USPGPub 2003/0110011 – "*Kyotoku*") in view of *Wall* (USPGPub 2002/0017977 – "*Wall*") and *Baese et al.* (USPGPub 2002/0082025 – "*Baese*") is to be reviewed on Appeal.

The Examiner's rejection of Claim 14 is improper since the cited prior art does not teach or suggest all of the limitations of the claim.

The Examiner cites paragraph [0011] of *Baese* for teaching the limitation of a local enterprise generated signal being "confined to a single room." The cited passage from *Baese* states:

> [0011] In screened regions (e.g., regions in which there is no mobile radio reception, GPS reception, etc.) it is possible to generate indoor position data, the position data of the vehicle within the screened structure, using permanently installed beacons, such as, for example, bluetooth transmitter/receiver devices. In this way, the position of the motor vehicle can be determined, even within screened regions, both at the motor vehicle end during the determination of its position and at a mobile radio terminal when the owner of the vehicle is searching for the motor vehicle.

That is, the cited passage states that if a signal cannot get in ("regions in which there is no mobile radio reception, GPS reception, etc.), then a local interior signal can be used. However, there is no suggestion that the local interior signal is to be confined within the interior region. While Appellants recognize that "Bluetooth®" type devices have a limited range, there is no prohibition against *Baese's* system having a vehicle that is parked near a wall or window, which would permit the Bluetooth® signal to escape from the interior area.

As a combination of the cited art does not teach or suggest the claimed feature of confining a local enterprise generated signal "to a single room," this rejection is not well founded and should be reversed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the various combinations of references. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the method comprising:

storing a first list of authorized location ranges where a client computer is authorized to receive a download of a first software from a server;

determining a physical location of the client computer;

comparing the physical location of the client computer with the first list of authorized location ranges;

downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges; and

downloading the first software only if the client computer does not receive information derived from a GPS signal.

2. The method of claim 1, further comprising:

upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges;

comparing the physical location of the client computer with the second list of authorized location ranges, and

downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges.

3. The method of claim 1, further comprising:

upon determining that the client computer is not located within an authorized area for a requested software download, generating an alert to a software administrator server of the unauthorized area in which the client computer is located while attempting to download a restricted application.

4. The method of claim 2, wherein the first and second lists of authorized location ranges are stored in the server.

5. (cancelled)

6. The method of claim 1, wherein the physical location of the computer is determined from a local enterprise generated signal.

7. The method of claim 6, wherein the local enterprise generated signal is confined to a single room.

8. A system for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the system comprising:

means for storing a first list of authorized location ranges where a client computer is authorized to receive a download of a first software from a server;

means for determining a physical location of the client computer;

means for comparing the physical location of the client computer with the first list of authorized location ranges;

means for downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges;

means for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges;

means for comparing the physical location of the client computer with the second list of authorized location ranges, and

means for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges.

9. (cancelled)

10. The system of claim 8, further comprising:

means for, upon determining that the client computer is not located within an authorized area for a requested software download, generating an alert to a software administrator server of the unauthorized area in which the client computer is located while attempting to download a restricted application.

11. The system of claim 8, wherein the means for storing the first and second lists of authorized location ranges are in the server.

12. The system of claim 8, wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal.

13. The system of claim 8, wherein the physical location of the computer is determined from a local enterprise generated signal.

14. The system of claim 13, wherein the local enterprise generated signal is confined to a single room.

15. A computer program product, residing on a computer storage medium, for regulating a download of a software from a server to a client computer on a network, the regulating being determined by a physical location of the client computer on which the software is to be downloaded, the computer program product comprising:

program code for storing a first list of authorized location ranges where a client computer is authorized to receive a download of a first software from a server;

program code for determining a physical location of the client computer;

program code for comparing the physical location of the client computer with the first list of authorized location ranges;

program code for downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges; and

program code for downloading the first software only if a Global Positioning System (GPS) receiver on the client computer does not detect a GPS signal.

16. The computer program product of claim 15, further comprising:

program code for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges;

program code for comparing the physical location of the client computer with the second list of authorized location ranges, and

program code for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges.

17. The computer program product of claim 16, wherein the first and second lists of authorized location ranges are stored in the server.

18. (cancelled)

19. The system of claim 8, further comprising:

means for, in response to determining that the second software is not authorized to be downloaded to the client computer at a current physical location for the client computer, evaluating subsequent alternate programs until an authorized program is located on the server, and downloading the authorized program from the server to the client computer.

EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.